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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/322,333	05/28/1999	TAKESHI KONDO	1217-990766	7839

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EXAMINER

ZIRKER, DANIEL R

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 10/02/2002

19

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-19

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 9/5/02
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-8 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 5-8 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The Examiner has withdrawn the final rejection previously set forth in Paper No. 16.

3. Claims 5-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP -355, substantially for the reasons set forth during the prior prosecution history, particularly in paragraph No. 3 of Paper No. 5, together with the following additional observations. As has previously been set forth, the reference discloses (note particularly the Abstract, page 2, lines 46-50, page 3 lines 11-24, lines 45-48, page 4 lines 22-26, Example 1, claim 1) a genus of pressure sensitive adhesive sheets comprising a pressure sensitive adhesive layer that can be formed by members of applicants' genus of urethane acrylate oligomers such as are shown on page 7 of the specification of the requisite molecular weights such as are shown on page 7 of the specification. Additionally, the claimed performance parameters relating to the maximum values of dynamic viscoelasticity in Young's modulus as applicants claim would necessarily be either inherent since the reference uses the same materials as do applicants in the same amounts as applicants, or would at most be an obvious optimization to one of ordinary skill in the semiconductor grinding art. Additionally, although the reference ^{may} ~~is~~ not ^{be} an

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anticipation because it ^{may} fail to teach adhering the pressure sensitive adhesive sheet to an adherend that has a surface having a high difference of at least 30 microns, this is also believed to merely cite what one of ordinary skill in the art would consider a nominal method of use claim for each of applicants' claims 5-8. In summary, applicants are using a genus of well known adhesive sheets to operate in their intended environment in a well known method to one of ordinary skill in the art, and as such what parameters that are not either expressly or inherently disclosed are each believed to be at most a routine optimization to one of ordinary skill, in the absence of unexpected results. Applicants' arguments throughout the prosecution of this case have generally been limited to arguments designed to avoid any sort of comparison against the claims as prior art, which with respect to the adhesive compositions disclosed by the reference would obviously be detrimental to their cause since the reference teaches the most preferred genus of adhesives that applicants contemplate. Additionally, their remaining arguments have been mostly directed to arguing that the reference fails to expressly disclose their various performance parameters, which is not believed to carry significant weight, particularly since the Examiner has set forth a prima facie case and applicants have failed to rebut it.

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

September 30, 2002

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300-
1700

Daniel Zirker